

#8
8-13-03
JPR

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Goulden et al.
Serial No.: 10/023,160
Filed: 19-Dec-2001
Title: PROJECTION SYSTEM

Atty. Docket No.: NL00.0760
Group Art Unit: 2851
Examiner: Dowling, William C.

FAX RECEIVED

Commissioner for Patents
Alexandria, VA 22313-1450

AUG - 4 2003

Amendment/Reply to Office Action

TECHNOLOGY CENTER 2800

Sir:

In response to the non-final Office action of 9 May 2003, please reconsider the application in light of the following remarks.

REMARKS

Claims 1-8 are pending in this application.

The Examiner has rejected claims 1-8 under 35 U.S.C. 112, first paragraph. The Applicants respectfully traverse this rejection.

The Examiner asserts: "while embodiments are envisioned such embodiments have not been put to practice and thus the inventor did not have possession of the invention." The Examiner's attention is requested to MPEP 2163, which quotes *Pfaff v. Wells Electronics, Inc.*, 55 U.S. at 66, 119 S.Ct. at 311, 48 USPQ2d at 1646: "It is true that reduction to practice ordinarily provides the best evidence that an invention is complete. But just because reduction to practice is sufficient evidence of completion, it does not follow that proof of reduction to practice is necessary in every case. Indeed, ... one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice."

The Examiner further asserts that the description fails to adequately describe how a clock can project dots and images of notes. MPEP 2163 further states: "The description need only describe in detail that which is new or not conventional", and "if the art has established a strong correlation between structure and function, one skilled in the art would be able to predict with a reasonable degree of confidence the structure of the claimed invention from a recitation of its function. Thus, the written description